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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,948	12/30/2003	Douglas E. Pittman	P-108547.1(CON)(CIP)	7881
7590 06/16/2004			EXAMINER	
Thomas E. Sisson JACKSON WALKER L.L.P. Suite 2100 112 E. Pecan Street San Antonio, TX 78205			CEGIELNIK, URSZULA M	
			ART UNIT	PAPER NUMBER
			3712	
DATE MAILED: 06/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/748,948	<b>Applicant(s)</b> PITTMAN, DOUGLAS E.	
	<b>Examiner</b> Urszula M Cegielnik	<b>Art Unit</b> 3712	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/30/03, 04/05/04</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 7 recite "outer side walls" and "arcuate inner walls". It is not clear whether applicant is intending to structurally claim the "outer side walls" and "arcuate inner walls" or not.

Claims 2 and 8 recite the limitation "said stick members" in line 1. There is insufficient antecedent basis for this limitation in the claims.

### ***Double Patenting***

Claims 1-8 are rejected under the judicially created doctrine of non-statutory double patenting as being unpatentable over claims 1-12 of US Patent No. 6,435,688. Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used. For example, the limitation "rolling member" in claims 1-8 of the application is an obvious variation in meaning of the limitation "stick member" in patent claims 1-12 because "rolling member" and "stick member" are disclosed as being the same feature.

Claims 1-8 are rejected under the judicially created doctrine of non-statutory

double patenting as being unpatentable over claims 1-6 of US Patent No. 6,679,614.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they set forth subject matters which are obvious over each other and only differ in breadth of terminology used. For example, the limitation "rolling member" in claims 1-8 of the application is an obvious variation in meaning of the limitation "stick member" in patent claims 1-6 because "rolling member" and "stick member" are disclosed as being the same feature.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Bears.

Bears discloses a toy and toy kit for creating visual and aural patterns having component parts capable of being assembled in the field, said kit comprising an inflatable bladder (2) having an inlet port (5); one or more rolling members (col. 3, lines 20 and 33) sized and shaped to be passable through said inlet port (5) when said bladder (2) is in a deflated condition (*the rolling members are capable of being passable through the inlet port [col. 1, lines 60-63] when the bladder is in a deflated condition or inflated condition since the reference states that the bladder is resilient and elastic [col.1, lines 60-61] and of one-piece construction in the form of a balloon, which would*

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*mean that it is capable of being stretched*), said one or more rolling members (3) visible outside said bladder (2) when said bladder is in an inflated condition (col. 4, lines 3- 5) said one or more rolling members (3) having outer side walls cooperating with arcuate inner walls (see Figure 1) of said bladder when said bladder is inflated such that said members (3) contact and roll lengthwise along said walls (col. 2, lines 29-36); and a sealing closure (col. 2, lines 12-18) adapted to be affixed to said inlet port (5) after said bladder (2) has been inflated with said members (3) therein; said members (3) are spherical balls (col. 3, lines 20 and 33), a toy for creating visual and audial patterns comprising an inflatable bladder (2) having an inlet port (5); one or more rolling members (3) sized and shaped to pass through said inlet port (5) when said bladder (2) is in a deflated condition, said rolling members (3) visible outside said bladder (col. 4, lines 3- 5) when said bladder is in an inflated condition (col. 2, lines 29-36) *(the rolling members are capable of being passable through the inlet port [col. 1, lines 60-63] when the bladder is in a deflated condition or inflated condition since the reference states that the bladder is resilient and elastic [col. 1, lines 60-61] and of one-piece construction in the form of a balloon, which would mean that it is capable of being stretched)*; said rolling members (3) (col. 3., lines 20 and 33) having outer side walls cooperating with arcuate inner walls (see Figure 1) of said bladder (2) when said bladder (2) is inflated such that said members (3) contact and roll lengthwise along said walls (col. 2, lines 29-36); and a sealing closure (col. 2, lines 12-18) affixed to said inlet port (5) to prevent deflation of said inflated bladder (2).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bears in view of Tarazaga Carrasco.

Bears discloses the claimed invention except for a one-way check valve.

Tarazaga Carrasco discloses a one-way check valve for inflatables.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a one-way check valve as taught by Tarazaga Carrasco, since Tarazaga Carrasco states at col. 1, lines 51-58, that such a modification would permit improved regulation of gas to and from the balloon.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Urszula M. Cegielnik whose telephone number is 703-306-5806. The examiner can normally be reached on Monday through Friday, from 5:30AM - 2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on 703-308-1745. **The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for both regular and After Final communications.**

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at 703-306-5648.

Urszula M. Cegielnik  
Assistant Examiner  
Art Unit 3712

A handwritten signature in dark ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

**DERRIS H. BANKS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**